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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,868	12/05/2000	Kenneth C. Gross	0066.99	9165

7590 03/25/2002

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/701,868

Applicant(s)

GROSS ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim(s) 1-18 and 22-26, drawn to an isolated nucleic acid molecule, a method of making a recombinant vector, a recombinant vector, a recombinant host cell, and a recombinant method for producing  $\beta$ -galactosidase II polypeptide. Restriction to a single nucleotide sequence is also required under 35 U.S.C. 121 and 372. Therefore, if Group I is elected, election of one nucleotide sequence is also required.

**Group II**, claim(s) 19, drawn to an isolated  $\beta$ -galactosidase II polypeptide. Restriction to a single amino acid sequence is also required under 35 U.S.C. 121 and 372. Therefore, if Group III is elected, election of one amino acid sequence is also required.

**Group III**, claim(s) 20, drawn to an isolated polypeptide comprising an epitope-bearing portion of the  $\beta$ -galactosidase II protein.

**Group IV**, claim(s) 21, drawn to an isolated antibody.

**Group V**, claim(s) 27-31, drawn to a method of modifying cell wall metabolism in a plant by transformation with a DNA adapted to modify the activity of a  $\beta$ -galactosidase, a plant cell, a plant and a seed. Restriction to a single nucleotide sequence is also required

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under 35 U.S.C. 121 and 372. Therefore, if Group VI is elected, election of one nucleotide sequence is also required.

**Group VI**, claim(s) 32, drawn to a method of modifying  $\beta$ -galactosidase II gene expression in a plant by transformation with a DNA sequence encoding  $\beta$ -galactosidase II polypeptide. Restriction to a single nucleotide sequence is also required under 35 U.S.C. 121 and 372. Therefore, if Group VII is elected, election of one nucleotide sequence is also required.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the inventions of Groups I-VI appears to be a DNA sequence encoding a  $\beta$ -galactosidase II protein or polypeptide. However, a DNA sequence encoding a  $\beta$ -galactosidase II protein or polypeptide is obvious or anticipated over any of ROSS et al. (1994, Plant Physiology Vol. 106, No. 2, pages 521-528), CARY et al. (1995, Plant Physiology Vol. 108, pages 1099-1107), KING et al. (1995, Plant Physiology Vol. 108, pages 419-420), or RAGHOTHAMA et al. (1991, Plant Molecular Biology, Vol. 17, pages 61-71). Therefore, the technical feature linking the inventions of Group I-VI does not constitute a special technical feature as defined by PCT Rule 13.2, because it does not define a contribution over the prior art. Furthermore, the method of Group V is distinct from the method of Group VI, because the method of Group V requires the use of a DNA adapted to modify the activity of a  $\beta$ -galactosidase, whereas the method of Group VI requires the use of a DNA sequence encoding  $\beta$ -galactosidase II polypeptide.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



CC  
March 21, 2002

AMY J. NELSON, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600